



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,589	02/27/2002	Andrew G. Carlson	60001.0109USC2	8240

7590 11/05/2004
Jeramie J. Keys
MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903

EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
----------	--------------

2141

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,589

Applicant(s)

CARLSON ET AL.

Examiner

Paul H Kang

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-49, 51-55 and 57-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-49, 51-55 and 57-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/29/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-45, 50, 56 and 60-79 were cancelled in a previous amendment. Claims 46-49, 51-55 and 57-59 are now pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 46-49, 51-55, and 57-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Holt et al., US Pat. No. 5,557,723.

4. As to claims 46, 53 and 59, Holt teaches an electronic mail system for transmitting an item, said item including a plurality of properties, a computer-implemented method for transmitting custom form data as part of said item (col. 1, line 15 – col. 2, line 20), comprising:

obtaining said custom form data, said custom form data including at least one field for displaying field data stored in at least one of said plurality of properties and control data for controlling the layout of the at least one field (col. 1, line 15 – col. 2, line 20 and col. 3, line 32 – col. 4, line 65);

storing said custom form data in one of said plurality of properties in response to obtaining said custom form data and transmitting said item to a recipient (col. 2, line 44 – col. 3, line 31).

5. As to claims 47, 49 and 55, Holt teaches an electronic mail system for receiving an item, a method for displaying an item comprising:

receiving said item, said item including a plurality of properties (col. 2, line 45 – col. 3, line 15);

determining whether said item includes a form property that includes custom form data and in response to a determination that said message item includes said form property, retrieving said custom form data stored in said form property; otherwise, retrieving form data from a form registry (col. 12, lines 22-54); and

displaying said item in the context of a form, said form being defined by said form data or said custom form data that includes at least one field and control data for controlling the layout of the at least one field (col. 12, lines 55-59).

6. As to claims 47, 51 and 57, Holt teaches receiving said field data from said at least one field as input and storing said field data in said at least one of said plurality of properties (col. 2, line 44 – col. 3, line 31).

7. As to claims 52 and 58, Holt teaches said form data or said custom form data defines the layout and comprises data corresponding to a plurality of fields of said form, and wherein

Art Unit: 2141

information is displayed in said fields, said information being stored in at least one of said plurality of properties (col. 2, line 44 – col. 3, line 31).

8. As to claims 48 and 54, Holt teaches obtaining said custom form data comprises displaying the form, altering the form in response to input, and creating said custom form data corresponding to said altered form (col. 10, line 66 – col. 11, line 28).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL H. KANG
PRIMARY PATENT EXAMINER